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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,918	02/25/2004	Jean-Yves Coillard-Lavirotte	52022/TJD/M881	4980

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EXAMINER

HOFFMAN, MARY C

ART UNIT	PAPER NUMBER
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3733

DATE MAILED: 11/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/786,918	Applicant(s) COILLARD-LAVIROTTE ET AL.	
	Examiner Mary Hoffman	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-10 and 13-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-10 and 13-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/14/2006 has been entered.

Allowable Subject Matter

Upon further consideration, the allowability indicated by the previous examiner of claims 4 and 8 (now cancelled and rewritten into independent claims) is withdrawn.

Rejections are as follows.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 5, 7-10, 13-14, 16-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Maruyama et al. (U.S. Patent No. 5,487,741).

Maruyama et al. disclose a miniplate comprising an anchor and positioning stud (FIG. 1, ref. #4) at one of its ends approximately perpendicular to the miniplate and an adjacent hole (FIG. 1, ref. #2a) for an attachment screw, designed to cooperate with a widest proximal end of the phalange and secondly at least one other hole (ref. #2a) for an attachment screw in the said miniplate and designed to cooperate with a distal end of the same phalange, wherein the miniplate has an anatomic profile in its frontal plane (ref. #2b) and in its sagittal plane, wherein the frontal plane has a widened area to approximately cover the widest proximal end of the phalange, wherein the stud and the adjacent hole for an attachment screw are designed to cooperate with the widest proximal end of the phalange and are adapted to be positioned approximately on a same traverse axis (x, x') of the phalange for better use of the available surface in this widened area of the phalange and wherein the stud is separated from the hole intended for the adjacent attachment screw by a hollowed-out part (see FIG. 2, narrow part of plate 1 between hole ref. #2a and ref. #4) formed in the said anatomic miniplate between the said stud and the said attachment hole. The sagittal plane of the anatomic miniplate is significantly curved to match the corresponding profile of the phalange (col. 3, lines 64-end, and col. 4, lines 1-4). The anatomic miniplate forms a single-piece part. The anatomic miniplate is made from titanium (col. 3, line 55). The frontal and sagittal anatomic profiles of the anatomic mini-plate correspond to a right foot phalange or a left foot phalange respectively.

U.S. Patent

Jan. 30, 1996

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5,487,741

FIG. 1

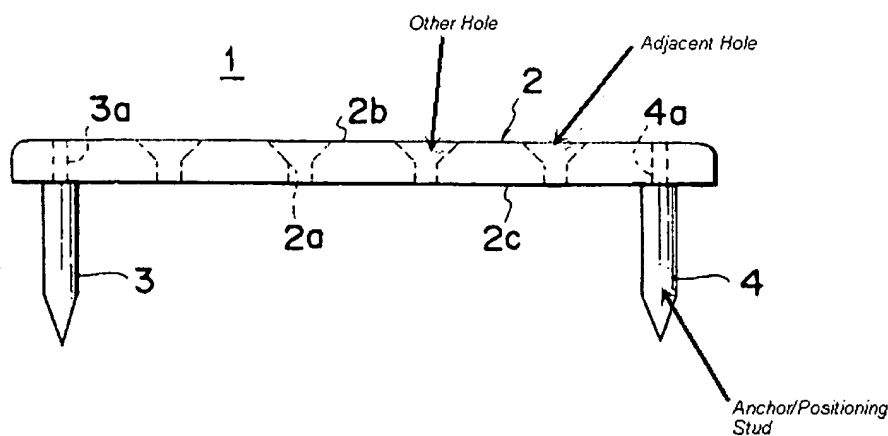
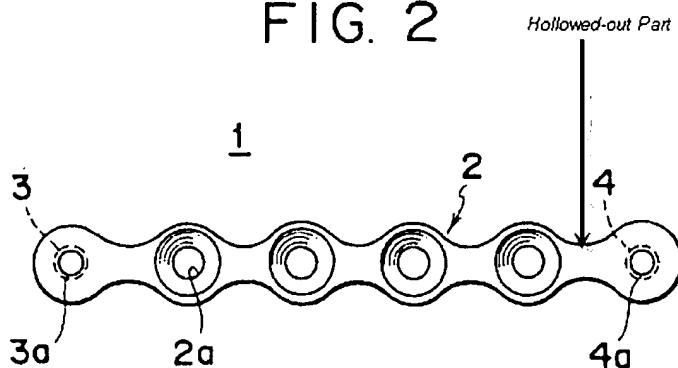


FIG. 2



Claims 1-2, 5-6, 8-10, 13-15, 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Mortier (U.S. Patent No. 5,810,822).

Mortier discloses a miniplate (see marked up figure below) comprising an anchor and positioning stud at one of its ends approximately perpendicular to the miniplate and an adjacent hole for an attachment screw, designed to cooperate with a widest proximal end of the phalange and secondly at least one other hole for an attachment screw in the

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said miniplate and designed to cooperate with a distal end of the same phalange, wherein the miniplate has an anatomic profile in its frontal plane and in its sagittal plane, wherein the frontal plane has a widened area to approximately cover the widest proximal end of the phalange, wherein the stud and the adjacent hole for an attachment screw are designed to cooperate with the widest proximal end of the phalange and are adapted to be positioned approximately on a same traverse axis (x, x') of the phalange for better use of the available surface in this widened area of the phalange and wherein the stud is separated from the hole intended for the adjacent attachment screw by a hollowed-out part formed in the said anatomic miniplate between the said stud and the said attachment hole. The sagittal plane of the anatomic miniplate is significantly curved to match the corresponding profile of the phalange. The anatomic miniplate forms a single-piece part. The anatomic miniplate is made from stainless steel (col. 4, line 31). The frontal and sagittal anatomic profiles of the anatomic mini-plate correspond to a right foot phalange or a left foot phalange respectively.

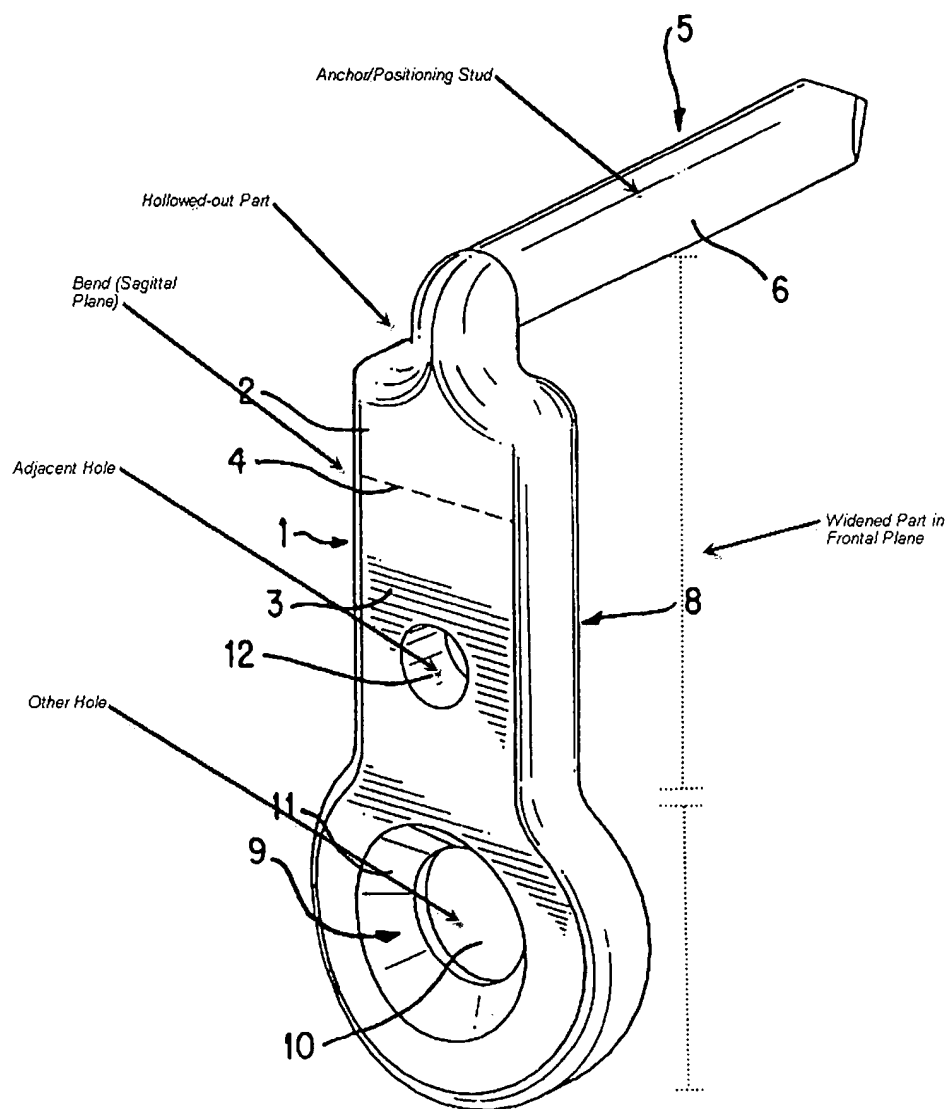


FIG. 5

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With regards to claim 5, 10, 14, and 18, these claims include the limitations “obtained by cutting a metal blank according to the sagittal plane and then stamping according to the frontal plane and folding the stud at an angle equal to approximately 90°”. These are being treated as product-by-process claims. In a product by process claim, if the applied reference reasonably indicates that a product disclosed therein is the same or substantially the same as the claimed product, the burden shifts to the applicant to provide evidence to the contrary.

With regard to the statements of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over the Maruyama et al. and Mortier references, which are capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference “teach” what the subject patent teaches, but rather it is only necessary that the claims under attack “read on” something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6 and 15 are rejected under 35 U.S.C. 103(a) as being obvious over Maruyama et al. (U.S. Patent No. 5,487,741).

Maruyama et al. disclose the claimed invention except for the anatomic miniplate being made from stainless steel. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Maruyama et al. being made of stainless steel, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Claims 7 and 16 are rejected under 35 U.S.C. 103(a) as being obvious over Mortier (U.S. Patent No. 5,810,822).

Mortier discloses the claimed invention except for the anatomic miniplate being made from titanium. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Mortier being made of titanium, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Response to Arguments

Applicant's arguments with respect to claims 1-2, 5-10 and 13-19 have been considered but are moot in view of the new ground(s) of rejection.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Hoffman whose telephone number is 571-272-5566. The examiner can normally be reached on Monday-Friday 9:00-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo C. Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MCH



EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER